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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/301,766 04/29/99 WATANABE

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002292 HM12/0119  
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EXAMINER

ZAGHMOUT, O

ART UNIT

PAPER NUMBER

1649

DATE MAILED:

01/19/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/301,766**

Applicant(s)  
**Watanabe et al.**

Examiner  
**Ousama Zaghmout**

Group Art Unit  
**1649**



☒ Responsive to communication(s) filed on Apr 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-27 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10, 16-23 are drawn to raffinose synthase gene of SEQ ID: 1, 3-8, vector, transformed host cells including plant cells, and a method of producing raffinose synthase in host cells, classified in class 800, subclass 278 for example.

II. Claims 11-12, 14 are drawn to a nucleic acid comprising a partial nucleotide sequence and a method for detecting a nucleic acid molecule by hybridization, classified in class 536, subclass 24.3 for example.

III. Claims 13, 15 are drawn to a method for amplifying a nucleic acid molecule by Polymerase Chain Reaction (PCR), classified in class 435, subclass 6 for example.

IV. Claims 24-27 are drawn to a raffinose synthase comprising the amino acid sequence represented by SEQ ID: 1,3,5 and 7, classified in class 530, subclass 350 for example.

2. The inventions are distinct, each from the other because of the following reasons:

a. Each invention is drawn to molecularly and biochemically divergent products and processes not required by the other.

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b. Invention of group I requires the use of a full length nucleotide sequence, transformation processes and transformation products, which are not required by the inventions of groups II-III which require the use of less than full length nucleotide sequence that can be used in hybridization or a PCR assays. These not full length fragments can not be used in expression of a gene.

c. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acid of group II can be used in detecting other nucleic acid molecules by hybridization.

d. Invention of group IV is drawn to an isolated protein not required by any other group, and can be made by process other than the expression of the nucleotide sequences of inventions I-III, such as chemical synthesis.

As such, the invention in each one of these groups require separate search and it can be burden on the Examiner to examine more than one invention in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

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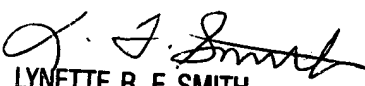
**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.  
January 12, 2000

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
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